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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/656,494	09/05/2003	Dirk Balfanz	A2124-US-CIP1	8357
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PARC c/o PARK, VAUGHAN & FLEMING LLP 2820 FIFTH STREET DAVIS, CA 95618-7759			EXAMINER PATEL, NIRAV B	
			ART UNIT 2135	PAPER NUMBER
			MAIL DATE 07/13/2007	DELIVERY MODE PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary

Application No.

10/656,494

Applicant(s)

BALFANZ ET AL.

Examiner

Nirav Patel

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 16 April 2007.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-25 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-25 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date _____
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: _____

DETAILED ACTION

1. This action is in response to the communication filed on 4/16/07. Claims 1-25 are pending.

2. Applicant's election without traverse of the elected species 1, claims 1-25, in the reply filed on 4/16/07 is acknowledged. Claim 26-55 are withdrawn and canceled by the applicant from further consideration pursuant to 37 CFR 1.142(b) as being drawn to a nonelected species 2, there being no allowable generic or linking claim. Election was made **without** traverse in the reply filed on 4/16/07.

Specification

3. The disclosure is objected to because of the following informalities: The reference to application numbers provided in page 1 needs to be updated to reflect applications that have matured into patents. Appropriate correction is required.

Claim Rejections - 35 USC § 101

35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

4. Claims 1-12 are rejected under 35 U.S.C. 101 because the subject matter is directed to non-statutory subject matter.

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Claims 1-12 are directed to a computer controlled method which could be a program/software/set of instructions. The examiner asserts that the limitation of the above claims raise a question as to whether or not the, the limitation actually claims the program or not. The above claims would have established a statutory category of the invention if the program recited in the above claims were stored on an appropriate medium and perform the function recited on the body of the claims when the program is read and executed by the computer/processor. However the above claims are simply computer controlled method which could be programs and thus do not clearly establish a statutory category of the invention. Therefore the claim is a program per se and does not fall within the statutory classes listed in 35 USC 101. The language of the claims raises a question as to whether the claims are directed merely to an abstract idea that is not tied to a technological art, environment, or machine which would result in a practical application producing a concrete, useful, and tangible result to form the basis of statutory subject matter under 35 U.S.C. 101. See MPEP § 2106 IV. B. 1(a).

Double Patenting

The **nonstatutory double patenting** rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and, *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

5. Claim 1-25 are provisionally rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims 1, 2, 5-7,10,17 of copending Application No. 10/656550 and in view of claims 1, 2 of copending Application No. 10/656439.

Although the conflicting claims are not identical, they are not patentably distinct from each other because the present application is obvious in view of the copending applications. The copending application (10/656550) discloses "exchanging key commitment information over said preferred channel between said provisioning device and said network device to pre-authenticate said network device", further, the copending application (10/656439) discloses "establishing communication between a provisioning device and a network device over a preferred channel; and providing provisioning information to said network device over said preferred channel, whereby said network device can automatically configure itself for communication over a network responsive to said provisioning information" as the presented in the present application. It would have been obvious to one of ordinary skill in the art at the time of the invention to establish a communication channel and configure the device for communication over

a network as taught by 0/656439, so as to create a secure credential infrastructure (such as PKI) [paragraph 0022, 10/656439].

This is a provisional obviousness-type double patenting rejection.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

6. Claims 1, 2, 7, 8, 13, 16, 17 and 21 are rejected under 35 U.S.C. 102(b) as being anticipated by Hermann, Reto (European Patent Publication No. EP1024626A1) (Publication Date 08/02/2000, submitted with IDS).

As per claim 1, Hermann discloses:

establishing communication between a provisioning device and a network device over a preferred channel [Fig. 1, 2, paragraph 0019]; exchanging key commitment information over said preferred channel between said provisioning device and said network device to pre-authenticate said network device [Fig. 1, 2 paragraph 0020, 0021, 0022]; and providing provisioning information to said network device over said preferred channel, whereby said network device can automatically configure itself for communication over

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a network responsive to said provisioning information [Fig. 1, 2, paragraph 0020, 0021, 0022].

As per claim 2, the rejection of claim 1 is incorporated and Hermann discloses:

said provisioning information comprises network configuration information [paragraph 0021 lines 38-40].

As per claim 7, the rejection of claim 1 is incorporated and Hermann discloses:

said preferred channel is a location-limited channel [Fig. 1, 2, paragraph 0026, 0035].

As per claim 8, the rejection of claim 1 is incorporated and Hermann discloses:

said preferred channel has a demonstrative identification property and an authenticity property [paragraph 0026, 0027].

As per claim 13, it encompasses limitations that are similar to those of claim 1. Thus, it is rejected with the same rationale applied against claim 1 above.

As per claim 16, it encompasses limitations that are similar to those of claim 1. Thus, it is rejected with the same rationale applied against claim 1 above.

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As per claim 17, the rejection of claim 16 is incorporated and it encompasses limitations that are similar to those of claim 2. Thus, it is rejected with the same rationale applied against claim 2 above.

As per claim 21, the rejection of claim 16 is incorporated and it encompasses limitations that are similar to those of claim 7. Thus, it is rejected with the same rationale applied against claim 7 above.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

7. Claims 3-6, 12, 14, 18-20 and 25 are rejected under 35 USC 103 (a) for being unpatentable over Hermann, Reto (European Patent Publication No. EP1024626A1) (Publication Date 08/02/2000, submitted with IDS) and in view of Harrisville-Wolff et al (US Pub. No. 2004/0030887).

As per claim 3, the rejection of claim 1 is incorporated and Hermann teaches receiving a key from the network device [Fig. 1, 2, paragraph 0021].

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Harrisville-Wolff teaches: receiving a public key from said network device [paragraph 0019 lines 3-5]; verifying said public key with said key commitment information [paragraph 0019 lines 5-12]; and automatically provisioning said network device with a credential authorized by a credential issuing authority [paragraph 0018 lines 14-20].

Therefore, it would have been obvious to a person of ordinary skill in the art at the time the invention was made to combine Harrisville-Wolff with Hermann, since one would have been motivated to provide secure transactions and communications between any two devices [Harrisville-Wolff, paragraph 0010 lines 1-5].

As per claim 4, the rejection of claim 3 is incorporated and Harrisville-Wolff teaches: establishing proof that said network device is in possession of a private key corresponding to said public key [paragraph 0012 lines 17-21].

As per claim 5, the rejection of claim 3 is incorporated and Harrisville-Wolff teaches: said credential issuing authority is a certification authority and said credential is a public key certificate [Fig. 2, paragraph 0018 lines 14-20].

As per claim 6, the rejection of claim 3 is incorporated and Harrisville-Wolff teaches: the step of automatically provisioning is responsive to authorization from a registration agent paragraph 0023 lines 10-13].

As per claim 12, the rejection of claim 1 is incorporated and Harrisville-Wolff teaches:

said provisioning device is in communication with a credential issuing authority [Fig. 1, 2].

As per claim 14, the rejection of claim 13 is incorporated and it encompasses limitations that are similar to those of claim 3. Thus, it is rejected with the same rationale applied against claim 3 above.

As per claim 18, the rejection of claim 16 is incorporated and it encompasses limitations that are similar to those of claim 3. Thus, it is rejected with the same rationale applied against claim 3 above.

As per claim 19, the rejection of claim 18 is incorporated and Hermann teaches:
a key exchange mechanism configured to be able to perform a key exchange protocol with said network device paragraph 0014 lines 41-43].

As per claim 20, the rejection of claim 18 is incorporated and it encompasses limitations that are similar to those of claim 5. Thus, it is rejected with the same rationale applied against claim 5 above.

As per claim 25, the rejection of claim 16 is incorporated and it encompasses limitations that are similar to those of claim 12. Thus, it is rejected with the same rationale applied against claim 12 above.

8. Claims 9, 15 and 22 are rejected under 35 USC 103 (a) for being unpatentable over Hermann, Reto (European Patent Publication No. EP1024626A1) (Publication Date 08/02/2000, submitted with IDS) and in view of Thompson et al (US Pub. No. 2002/0022483).

As per claim 9, the rejection of claim 1 is incorporated and Harrisville-Wolff teaches the network is a wireless network [paragraph 0021].

Thompson teaches the network is a wireless network, and wherein said provisioning device is a wireless access point [Fig. 1].

Therefore, it would have been obvious to a person of ordinary skill in the art at the time the invention was made to combine Thompson with Hermann, since one would have been motivated to provide secure communication session in the wireless communication [Hermann, paragraph 0019 line 5].

As per claim 15, the rejection of claim 13 is incorporated and it encompasses limitations that are similar to those of claim 9. Thus, it is rejected with the same rationale applied against claim 9 above.

As per claim 22, the rejection of claim 16 is incorporated and it encompasses limitations that are similar to those of claim 9. Thus, it is rejected with the same rationale applied against claim 9 above.

9. Claims 10, 11, 23 and 24 are rejected under 35 USC 103 (a) for being unpatentable over Hermann, Reto (European Patent Publication No. EP1024626A1) (Publication Date 08/02/2000, submitted with IDS) and in view of Thompson et al (US Pub. No. 2002/0022483) and in view of Harrisville-Wolff et al (US Pub. No. 2004/0030887).

As per claim 10, the rejection of claim 9 is incorporated and Thompson teaches:

receiving a wireless communication [Fig. 1]; determining whether said wireless communication originated from said network device or from a second network device that was not provisioned by said wireless access point; and routing said wireless communication responsive to the step of determining [Fig. 4 step 410, 412].

Therefore, it would have been obvious to a person of ordinary skill in the art at the time the invention was made to combine Harrisville-Wolff with Hermann and Thompson, since one would have been motivated to provide secure transactions and communications between any two devices [Harrisville-Wolff, paragraph 0010 lines 1-5].

As per claim 11, the rejection of claim 10 is incorporated and Thompson teaches:

choosing a selected channel from a secure channel and an insecure channel responsive to the step of determining; and sending said wireless communication through said selected channel [Fig. 4, paragraph 0116, 0118-0121].

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As per claim 23, the rejection of claim 22 is incorporated and it encompasses limitations that are similar to those of claim 10. Thus, it is rejected with the same rationale applied against claim 10 above.

As per claim 24, the rejection of claim 23 is incorporated and it encompasses limitations that are similar to those of claim 11. Thus, it is rejected with the same rationale applied against claim 11 above.

Conclusion

10. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

Deshpande et al (US 2002/0176579) --- Location-based service using wireless hotspot technology.

Haartsen (US 6519460) – Resource management in uncoordinated frequency hopping system

Nelson et al (US 2003/0095663) --- System and method to provide enhanced security in a wireless local area network system

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Any inquiry concerning this communication or earlier communications from the examiner should be directed to Nirav Patel whose telephone number is 571-272-5936. The examiner can normally be reached on 8 am - 4:30 pm (M-F).

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Kim Vu can be reached on 571-272-3859. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

NBP

7/5/07


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